IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 09/653,215	§	Examiner: Chen, Shin Hon
Filed: August 31, 2000	§	Group/Art Unit: 2131
Inventors:	§	Atty. Dkt. No: 5181-70400
Saulpaugh, et al.	§	P5200
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Title: Method and Apparatus to Obtain Service Capability Credentials	§	
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REPLY BRIEF

Dear Sir:

This brief is in reply to the Corrected Examiner's Answered mailed March 5, 2008. Appellants respectfully request that this Reply Brief be entered pursuant to 37 C.F.R. § 41.41 and considered by the Board of Patent Appeals and Interferences.

REPLY TO EXAMINER'S ANSWER

First Ground of Rejection:

Claims 1, 2, 5, 6, 9-18, 21, 22, 25-34, 37, 38 and 41-47 stand finally rejected under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470).

Claims 1, 2 and 16:

1.   **Adams fails to disclose a client receiving a capability credential that indicates that the client has the right <u>to use only a portion of a service's capabilities</u>, where <u>the portion is less that a total of the capabilities</u> provided by the first service.**

Adams teaches that any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion that is less than all of a service's provided capabilities. No mention is made in Adams of allowing access to only a portion of a service's capabilities. Please refer to Appellants Appeal Brief for a more detailed discussion of Adams' teachings.

In the Response to Arguments of the Examiner's Answer, p. 10, the Examiner cites column 5, lines 14-17 and lines 38-41 as well as column 6, lines 49-65, referring to Adams' teachings regarding a subscriber communicating a request for another application controlled by a relying party and regarding a certificate selector analyzing a subscriber's attribute certificates to determine whether any of them contain privilege data that is consistent with privilege test criteria. However, the teachings of Adams relied on by the Examiner do not disclose a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less that a total of the capabilities* provided by the first service. Instead, the Examiner's cited passage describes a particular manner in which Adams' system determines whether the subscriber certificates, such as data representing a subscriber unit's privilege status,

meet the particular required privilege test criteria data. Therefore, Adams does not anticipate claim 1.

2. The Examiner's interpretation of Adams is incorrect and not supported by the actual teachings of the reference.

In regard to the above-noted features of claim 1, the privilege test criteria data described in the portion of Adams cited by the Examiner is described by Adams as indicating "the specific privilege information necessary for the relying party to grant privilege to a subscriber unit" (Adams, column 3, lines 47-51). Thus, the portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a services capabilities. In the Response to Arguments, the Examiner states that Adams "pre-qualification privilege data sent to subscriber indicates the limited capabilities that a subscriber is entitled to with respect to all of the services provided by the relying party" (Examiner's Answer, p.10-11). The Examiner's statement is not supported by the actual teachings of the reference. The portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a services capabilities. Instead, the cited portions of Adams are teaching a particular method of determining whether a subscriber's privilege status meets the particular privilege requirements of a relying unit. As noted above, the certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, Adams makes no mention regarding allowing access to only a portion of a service's capabilities wherein the portion is less that a total of the capabilities provided by the service.

In the Response to Arguments, the Examiner also argues, "the privilege data returned by the selector entity indicates that the user has the right to use only certain portion of the service's capabilities" (Examiner's Answer, p. 10-11). Again, the Examiner's statement is not supported by the actual teachings of the reference. Adams' system determines whether subscriber certificates meet particular test criteria data. In other words, Adams' teaches that a subscriber's certificates are verified to ensure that the

particular type of certificate is an approved type. For example, Adams teaches that the privilege test criteria data may indicate the specific privilege information necessary for the relying part to grant privilege to the subscriber unit. Nowhere does Adams make any mention whatsoever of a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less that a total of the capabilities* provided by the first service.

3.   Adams clearly fails to meet the standard for anticipation in regard to Appellants' claim.

As shown above, Adams is simply not concerned with granting a client rights to use only a portion of a service's capabilities. Instead, Adams' teachings pertain to minimizing the number of certificates that must be transferred, and to preventing privilege data from being sent to non-privilege parties (Adams, column 2, lines 58-61 and column 3, lines 41-44). Adams contrasts his systems with previous systems that require the subscriber to present all attribute certificates to the relying party. Adams clearly does not teach a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, where the portion is less that a total of the capabilities provided by the first service. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The standard for anticipation is clearly not meet by the teachings of Adams in regard to claim 1.

Claim 5:

1.   Adams fails to disclose the client receiving an advertisement for the first service, where the advertisement describes the portion of the first service's capabilities.

The Examiner admits that Adams makes "no specific mention of the advertisement" but asserts, "advertisement serves as a way of letting the user be aware of the service[s] available" (Examiner's Answer, p. 5). The Examiner has clearly failed to provide a proper rejection of claim 5. By admitting that Adams does not disclose the use of an advertisement, the Examiner has clearly admitted that Adams fails to <u>anticipate</u> claim 5. *See* M.P.E.P 2131; *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Adams clearly does not describe receiving an advertisement (or anything else) for the first service, where the advertisement describes the portion of the first service's capabilities. Please refer to Appellants' Appeal Brief for a more detailed discussion of the portion of Adams cited by the Examiner in the rejection of claim 5.

2. The Examiner's own unsupported speculation is not a proper basis for anticipation.

The Examiner relies on his own unfounded opinion that "advertisement serves as a way of letting the user be aware of the service[s] available" (Examiner's Answer, p. 5). Thus, the Examiner is clearly relying on his own unsupported assumptions and speculations in hindsight regarding how Adams' system might work. However, the Examiner's statement that advertisements ***may*** serve as a way of letting a user know what services are available has absolutely no bearing on the fact that Adams fails to disclose anything about an advertisement for a service that *describes a portion of the service's capabilities*. The fact that Adam's system might benefit in hindsight from the use of such an advertisement, as suggested by the Examiner, is irrelevant to a rejection based on anticipation (i.e. § 102). The Examiner's statement is also unsupported by any evidence of record.

In the Response to Arguments, the Examiner argues that "advertisement achieved through the use of website is well known in the art" and that "subscribers are exposed to an advertisement when accessing a certain website and decided to request the service described in the advertisement" (Examiner's Answer, p. 11). Appellants traverse the

Examiner's statements in regard to the specific limitation recited in claim 5. Moreover, the Examiner's statements are completely unsupported in Adams or any other evidence of record.

3. The use of advertisements is NOT inherent in Adams.

As noted above, the Examiner admits that Adams fails to disclose the use of an advertisement that describes a portion of the service's capabilities. Furthermore, the Examiner has not shown that the use of advertisements is inherent in Adams' system. "The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic." M.P.E.P 2112.IV; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Instead, the Examiner merely repeats his own unfounded opinion that Adams' system would include advertisements, since "the subscriber must be aware of the service provided by the relying party and the capability of that service prior to using it" (Examiner's Answer, p. 11).

Moreover, regardless of whether or not Adams' subscribers must be aware of the service provided and the capability of that service prior to using it, the fact remains that Adams does not disclose the <u>specific</u> limitations of claim 5. As noted above and admitted by the Examiner, Adams makes no mention of advertisements as recited in claim 5, nor has the Examiner provided any evidence showing that advertisements are *necessarily present* in Adams' system. Instead, the Examiner has merely concluded in hindsight that the use of an advertisement might be beneficial, which as stated above, is completely speculative and unsupported.

In the Response to Arguments section of the Final Action and in the Advisory Action, the Examiner asserts that a subscriber request to access an application through Adams' relying party's website "indicates that the advertisement for certain services exist as to enable a subscriber to request privilege to use such service", citing column 5, lines 14 – 18 of Adams. The Examiner further asserts, "Adams inherently disclose[s] these limitation[s] as they are [an] essential requirement for a subscriber to request certain services provided by a relying party." (Final Action, p. 2). Thus, the Examiner's argument is that the mere fact that a subscriber unit requests the use of a service inherently discloses the specific limitations of claim 5. This assertion is clearly incorrect. Even if Adams could be said to inherently disclose an advertisement, which Appellants maintain it does not, the Examiner has still failed to show how Adams' system *inherently includes a client receiving* an advertisement *that describes the portion of the service's capabilities*.

4.   **Adams clearly fails to disclose that the indication of the set of desired capabilities included in the client's capability credential request message (claim 2) comprises an indication of the advertisement, as recited in claim 5.**

As noted above, Adams fails to mention anything about advertisements, as admitted by the Examiner. Furthermore, Adams does not mention anything about a client indicating a set of desired capabilities as part of requesting a capability credential, *where the indication of the set of desired capabilities includes an indication of an advertisement for a service*. As noted above, the Examiner has merely stated his own unfounded opinion that the use of advertisements would be beneficial to Adams' system without showing that Adams' system actually includes the use of advertisements. Moreover, the Examiner has not provided any argument, explanation, or evidence showing that Adams' system includes a client indicating a set of desired capabilities as part of requesting a capability credential, where that indication includes an indication of an advertisement for a service providing those capabilities.

The Examiner, in his Answer, states that "[w]ithout indicating the desired capabilities, the centralized privilege data selector will not be able to determine whether the capabilities associated with the subscriber are sufficient to access services provided by [the] relying party" (Examiner's Answer, p. 11-12). However, the Examiner is not relying on any specific teachings of the cited art, but instead merely relying on his own unfounded opinion and/or speculation. There is nothing in Adams that suggests that an indication of a set of desired capabilities including an indication of an advertisement for a service providing those capabilities would be required in Adams' system. As noted previously, the Examiner has not provided any extrinsic evidence that Adams' system necessarily includes a client receiving an advertisement for a service that describes a portion of the service's capabilities. Moreover, M.P.E.P. 2112.IV states, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" (underlining in original). The Examiner's unsupported opinion that Adams' system inherently includes the use of advertisements "as a way of letting the user be away of the service available" or "to enable a subscriber to request privilege to use such service" is incorrect and is not extrinsic evidence that makes clear that the use of advertisements as recited in Applicants' claim 5 is necessarily present in Adams' system. Moreover, the Examiner's statements do not address the specific requirement of claim 5 that the indication of the set of desired capabilities included in the client's capability credential request message *comprises an indication of the advertisement*.

Claim 6:

1.   **Adams fails to disclose that the indication of the advertisement is the advertisement itself.**

The Examiner, both in the rejection and in the Response to Arguments section of his Answer, cites column 5, lines 14-18. (Examiner's Answer, p. 12). However, the cited portion of Adams makes no mention of any *indication of an advertisement*, nor that such an indication of an advertisement is *the advertisement itself*. Furthermore, as discussed

above, the Examiner has admitted that Adams makes no mention of such an advertisement and has not shown that such an advertisement would inherently be used in Adams as specifically recited in claim 6. Please refer to Appellants' Appeal Brief for a more detailed discussion of Adams' system.

2.   **The claimed use of advertisements is not inherent in Adams.**

In the Response to Arguments of the Answer, p. 12, the Examiner seems to assert that the use of advertisements is inherent in Adams' system. Specifically, the Examiner states, "by indicating the relying party's identification, the indication of the advertisement is achieved since the advertisement is the website itself." Examiner's Answer, p. 12. The Examiner is clearly incorrect. Nowhere does Adams teach that the website describes a service's capabilities. In fact, the only mention in Adams regarding the website states, "the subscriber unit 200 may communicate a request over a global network link to a Website of the relying party requesting access to another application controlled by the relying party to facilitate a financial transfer." Adams, column 5, lines 14-18. Please refer to the remarks above regarding claim 5 for a detailed discussion regarding the fact that Adams' system does not inherently disclose the limitations of Applicants' claims.

Once again, the Examiner has failed to provide any extrinsic evidence, citation, explanation or interpretation illustrating that a subscriber unit's request *necessarily* indicates a set of desired capabilities that includes an indication of an advertisement (as recited in claim 5) where the indication of the advertisement is the advertisement itself, as recited in claim 6. Following the Examiner's line of reasoning (that the use of advertisements are inherent in Adams' system and that the website is the advertisement) a subscriber's request would also have to inherently *include the website itself*. Not only does this not make sense, there is nothing about Adams' system that inherently requires a subscriber unit to include a *website* as an advertisement (of which Adams makes no mention) in an indication of capabilities as part of requesting a capability credential. The Examiner's interpretation is clearly incorrect.

<u>Claim 9</u>:

1.   **Adams fails to disclose an advertisement that is a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities.**

The Examiner cites column 5, lines 14-18 where Adams teaches that a subscriber unit may send a request message to a website of a relying party to request access to another application controlled by the relying party to facilitate a financial transfer. Examiner's Answer, p. 12. As noted above regarding the rejection of claim 6, the cited passage makes absolutely no mention whatsoever of any advertisements of any kind, let alone a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities.

2.   **The Examiner's interpretation of Adams is incorrect and unsupported by the actual teachings of the reference.**

In the Response to Arguments section of the Examiner's Answer, p. 12, the Examiner cites column 5, lines 55 – 57 of Adams and refers to the fact that when verifying pre-qualification privilege data, Adams' verifier 106 may generate "[v]erification data 206 indicating a 'yes/no' result to accept the subscriber's privilege." Adams, column 5, lines 55 – 57. Appellants fail to see the relevance of a yes/no result from verifying pre-qualification privilege data to an advertisement indicated and received by a client being a protected advertisement that describes the service's capabilities but does not provide an interface to the first service's capabilities.

Firstly, Adams' data verifier 106 does not describe a service's capabilities nor provide an interface to the service's capabilities regardless of whether pre-qualification privilege data is verified or not. Secondly, the Examiner, regarding claims 6 and claim 5 (from which claim 9 depends), has already stated that he considers the website itself to be the advertisement (Response to Arguments regarding claims 5 and 6 in Examiner's

Answer, p. 11-12). Thus, according to the Examiner's logic, Adams' website would have to describe a service's capabilities but not provide an interface to the service's capabilities. The Examiner's interpretation is clearly incorrect and inconsistent. Adams website is clearly not equivalent to, nor does it disclose, the advertisement of Appellants' claims. Moreover, Adams' website clearly provides an interface to a service, and therefore, even under the Examiner's interpretation, Adams fails to anticipate claim 9.

Claims 10, 11 and 12:

1.   **Adams fails to disclose a client receiving a protected advertisement for the first service, where the protected advertisement indicates an address for sending the capability credential request message to.**

In the Response to Arguments section of the Examiner's Answer, p. 13, the Examiner cites column 5, lines 14 – 18 and column 6, lines 31 – 49. However, neither of the cited passage makes any mention of a client receiving a protected advertisement that indicates an address to which to sending a capability credential request message. The first cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The second cited passage describes a centralized privilege data selector that "selects among privilege data for a plurality of subscribers."

2.   **Adams' communication addresses in general do not disclose a *protected advertisement* indicating an address to send a capability credential request message to.**

The Examiner also states, in the Answer, that since "communication between each entity is through network communication, there must exist an identification for each entity in order to initiate communication between entities" and that "[t]herefore, an address for sending request is required in the system of Adams." Examiner's Answer, p.

13. Appellants agree that in order to send a request, the sender must know the address to which to send the request. However, simply because the address is required does not disclose the specific limitation of a *protected advertisement* indicating an address to send a capability credential request message to, as recited in Appellants' claims. The Examiner is not rejecting Appellants claims based on the actual teachings of the cited art. Instead, the Examiner is relying upon his own unfounded opinion and speculation regarding how Adams' system might work, despite no actual disclosure by Adams of those features relied upon by the Examiner. Since Adams is silent regarding a protected advertisement indicating an address for sending the capability credential request message to, Adams clearly fails to anticipate claim 10.

Claim 13:

Adams fails to disclose a client receiving a protected advertisement for the first service, where said protected advertisement indicates an authentication service and where said requesting a capability credential comprises the client requesting a capability credential from the authentication service.

The Examiner cites column 5, lines 14 – 18 and 54-57 in the Response to Arguments section of the Examiner's Answer, p. 13. However, as described previously, neither of these cited passages makes any mention of any advertisement and further fail to describe a protected advertisement that indicates an authentication service.

The Examiner also states in the Answer, "Adams discloses that a subscriber is allowed to understand what services the relying party provides but actual access to the service is granted after verification" referring to the fact that Adams' service is an application controlled by the relying party. Examiner's Answer, p. 13. The Examiner then concludes, "[t]herefore, Adams clearly discloses the protected advertisement that describes services provided but not the actual service itself." Examiner's Answer, p. 13. Appellants do not follow the Examiner's logic. Just because a subscriber may be granted access to a service after verification does not have anything all to do with and certainly

does not disclose the specific limitations of a protected advertisement as recited in claim 13. Furthermore the Examiner has not explained how the fact that Adam's subscriber may be granted access to a service after verification has anything to do with a protected advertisement indicating an authentication service. The specific limitations of claim 13 are not taught by Adams.

Claim 14:

1.   **Adams fails to disclose the authentication service determining a level of the first service's capabilities that the client is authorized to use.**

The passage in Adams cited by the Examiner in regard to this limitation describes Adams' centralized privilege data selector. Adams, column 6, lines 49-67. However, Adams' centralized privilege data selector does not have anything to do with determining a level of the service's capabilities that the client is authorized to use. As Adams states, a privilege data selector selects among a plurality of attribute certificates associated with a selected subscriber unit and that the privilege test criteria data may be generated by the relying party to indicate the specific privilege information necessary for the relying party to grant privilege to a subscriber unit (Adams, column 3, lines 44-51). In other words, the relying party indicates, by generating privilege test criteria data, what sort of privilege data is required to grant a subscriber unit privilege and the privilege data selector selects attribute certificates that match the test criteria data. Adams' centralized privilege data selector does not determine a level of a service's capabilities that a client is authorized to use. Instead, it merely determines which attribute certificates for a subscriber unit match the privilege test criteria data provided by the relying party.

2.   **The Examiner's interpretation of Adams is incorrect and unsupported by the actual teachings of the reference.**

In the Response to Arguments section of the Examiner's Answer, the Examiner argues that Adams' "pre-qualification privilege data sent by the centralized data selector

to a subscriber contains a set of privileges that the subscriber possesses and only the set of privileges included in the pre-qualification privilege data can the subscriber use to access service provided by relying party." Examiner's Answer, p. 14 citing column 6, lines 58-67 of Adams. However, this portion of Adams does not describe determining a level of the service's capabilities that the client is authorized to use. Instead, the cited passage describes the comparison of the subscriber's privilege data with the privilege test data to determine whether or not the subscriber holds a certificate of a type acceptable to the relying party. As shown previously, Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). Thus, Adams teaches that the centralized data selector compares those certificates (privilege data) held by the subscriber to the type of certificates (privilege test criteria) acceptable to the relying party.

3. **Adams does not disclose that the portion of a service's capabilities that a returned attribute certificate indicates that the subscriber unit has a right to use, is *no more than* the set of desired capabilities.**

Adams teaches only that his privilege data selector returns attribute certificates that match a particular set of privilege criteria test data. Nowhere does Adam teach that the portion of a service's capabilities that a returned attribute certificate indicates that the subscriber unit has a right to use, is *no more than* the set of desired capabilities.

Claim 15:

Adams fails to disclose that the portion of the first service's capabilities that the capability credential indicates that the client has a right to use, is the lesser of the level of the first service's capabilities that the client is authorized to use and the set of desired capabilities.

In his Answer, pp. 14-15, the Examiner again cites column 6, lines 51 – 67, where Adams describes the centralized privilege data selector that returns attribute certificates that match privilege criteria test data. However, as shown previously, the cited passage does not describe that the attribute certificates indicate a portion of a service's capabilities that a client has a right to use as being the lesser of the level of the service's capabilities that the client is authorized to use and the set of desired capabilities.

The Examiner also states, "the privilege data received by the subscriber is a subset of the total capabilities provided by the relying party because it is impossible to obtain capabilities of a relying party for which the relying party does not provide" (Examiner's Answer, p. 14-15). The Examiner's argument does not make any sense. The fact that it may be impossible to obtain capabilities that a relying party does not provide does not mean that in Adams' system a subscriber always (as implied by the Examiner) receives a subset of the total capabilities provided by a relying party. Since Adams is silent regarding that *the portion of the first service's capabilities that the capability credential indicates that the client has a right to use is the lesser of the level of the first service's capabilities that the client is authorized to use and the set of desired capabilities*, Adams clearly fails to anticipate claim 15. In fact nowhere does Adams teach anything regarding this limitation of claim 15.

Claims 17, 18, 31 and 32:

1.   **Adams fails to disclose an interface configured to receive over the connection a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, where the portion is less that a total of the capabilities provided by the first service.**

As described above regarding claim 1, Adams teaches a system for granting security privileges by providing test criteria data so that security privilege certificates (or other authorization credentials) may be selected from among multiple subscriber privilege data. Adams teaches that certificates, such as Kerberos tickets, privilege

attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). A selector entity may search a common repository of security privilege certificates. The selector entity then returns *any and all privilege data that meets the test criteria data.* Thus, the selector unit may return multiple certificates, each of each meets the test criteria data. *See*, Adams, column 3, lines 26-59; column 4, lines 25-36; and column 5, lines 18-46. **Adams does not mention anything about selecting and returning a certificate that indicates a subscriber unit (client) has the right to use *only* an indicated portion of a services capabilities**, which would be required for Adams to anticipate claim 1**.** Instead, Adams states that any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion that is less than all of a service's provided capabilities. No mention is made in Adams of allowing access to only a portion of a service's capabilities.

2. **The Examiner's interpretation of Adams is incorrect and unsupported by the actual teachings of the reference.**

The Examiner cites column 5, lines 14-32 of Adams and refers to Adams' teaching regarding a subscriber communicating a request for another application controlled by a relying party and regarding a certificate selector analyzing a subscriber's attribute certificates to determine whether any of them contain privilege data that is consistent with privilege test criteria. However, the teachings of Adams relied on by the Examiner do not disclose *an interface configured to receive a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less that a total of the capabilities provided by the first service.* Instead, the Examiner's cited passage describes a particular manner in which Adams' system determines whether the subscriber certificates, such as data representing a subscriber unit's privilege status, meet the particular required privilege test criteria data. Adams teaches that privilege test criteria data indicates "the specific privilege information necessary for the relying party to grant privilege to a subscriber unit"

(Adams, column 3, lines 47-51). Thus, the portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a services capabilities. Instead, the cited portions of Adams are teaching a particular method of determining whether a subscriber's privilege status meets the particular privilege requirements of a relying unit. As noted above, the certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, Adams makes no mention regarding allowing access to only a portion of a service's capabilities.

In the Advisory Action, the Examiner argues, "the privilege data returned by the selector entity indicates that the user has the right to use only certain portion of the service's capabilities." However, the Examiner's interpretation of Adams is incorrect. As described above, Adams' system determines whether subscriber certificates meet particular test criteria data. In other words, Adams' teaches that a subscriber's certificates are verified to ensure that the particular type of certificate is an approved type. For example, Adams teaches that the privilege test criteria data may indicate the specific privilege information necessary for the relying part to grant privilege to the subscriber unit. The Examiner is merely speculating in hindsight regarding Adams' system. As noted above, nowhere does Adams make any mention whatsoever of an interface configured to receive over the connection a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less that a total of the capabilities* provided by the first service.

3. **Adams is not concerned with granting rights to use only a portion of a service's capabilities.**

Instead, Adams is concerned with minimizing the number of certificates that must be transferred and also with preventing privilege data from being sent to non-privilege parties (Adams, column 2, lines 58-61 and column 3, lines 41-44). Adams contrasts his systems with previous systems that require the subscriber to present all attribute

certificates to the relying party. Adams does not describe granting rights to use only a portion of a service's capabilities.

4.   Adams clearly fails to meet the standard for anticipation in regard to Appellants' claim.

Anticipation requires the presence in a single prior art reference disclosure of <u>each and every limitation</u> of the claimed invention, <u>arranged as in the claim</u>. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The <u>identical invention</u> must be shown <u>in as complete detail</u> as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Adams *clearly* fails to disclose an interface configured to receive of the connection a capability credential that indicates that the client has the right <u>to use only a portion of a service's capabilities</u>, wherein <u>the portion is less that a total of the capabilities</u> provided by the first service. Therefore, Adams cannot be said to anticipate claim 17.

Claims 33, 34 and 47:

The reply stated above in regards to claims 1 and 17 applies to independent claim 33 for similar reasons.

Claims 21 and 37:

1.   Adams fails to disclose that the interface is configured to receive an advertisement for the first service, where the advertisement describes the portion of the first service's capabilities

The Examiner admits that Adams makes "no specific mention of the advertisement" but asserts, "advertisement serves as a way of letting the user be aware of the service[s] available" (Examiner's Answer, p. 5). The Examiner has clearly failed to

provide a proper rejection. By admitting that Adams does not disclose the use of an advertisement, the Examiner has clearly admitted that Adams fails to anticipate claims 21 and 37. The Examiner's statement regarding how advertisements may serve as a way of letting a user know what services are available has absolutely no bearing on the fact that Adams fails to disclose anything about an advertisement for a service that *describes a portion of the service's capabilities*. The fact that Adam's system might benefit from the use of such an advertisement, as suggested by the Examiner, is irrelevant to a rejection based on anticipation (i.e. § 102). The Examiner's statement is also unsupported by any evidence of record.

> **2.   The Examiner has neglected the standard for anticipation.**

A claim is "anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (M.P.E.P. § 2131). As admitted by the Examiner, Adams fails to disclose the use of an advertisement that describes a portion of the service's capabilities. Moreover, the Examiner has not shown that the use of advertisements is inherent in Adams' system. "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence" and "[s]uch evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference" (emphasis added, M.P.E.P. § 2131.01 III). As noted above and admitted by the Examiner, Adams makes no mention of advertisements, nor has the Examiner provided any evidence showing that advertisements are *necessarily present* in Adams' system. Instead, the Examiner has merely concluded that the use of an advertisement might be beneficial, which as stated above, is completely speculative and irrelevant. The Examiner is merely using hindsight speculation, which is clearly improper and does not meet the standard for anticipation. M.P.E.P. 2131.

3. The claimed use of advertisements is not inherent in Adams.

In the Response to Arguments and the Advisory Action, the Examiner asserts that a subscriber request to access an application through Adams' relying party's website "indicates that the advertisement for certain services exist as to enable a subscriber to request privilege to use such service", citing column 5, lines 14 – 18 of Adams. The Examiner further asserts, "Adams inherently disclose[s] these limitation[s] as they are [an] essential requirement for a subscriber to request certain services provided by a relying party." Thus, the Examiner's argument is that the mere fact that a subscriber unit requests the use of a service inherently discloses the specific limitations of claim 21. The Examiner is incorrect. Even if Adams could be said to inherently disclose an advertisement, which Appellants maintain it does not, the Examiner has still failed to show how Adams' system inherently includes a client receiving an advertisement that describes the portion of the service's capabilities.

The Examiner's cited portion of Adams (column 5, lines 14 –18) merely states that a subscriber unit may communicate a request over a global network link to a website of a relying party request access to another application controlled by the relying party to facilitate a financial transfer. The cited passage does not contain any teaching that may be considered to inherently include a client receiving an advertisement for a service that describes a portion of the service's capabilities. In fact, Adams does not describe anything about a client receiving any sort of information that describes a portion of a service's capabilities. Nor has the Examiner provided any explanation or interpretation of Adams that includes the subscriber unit, which the Examiner equates to the client of Applicants' claim, receiving any such information. Instead, the Examiner merely asserts that Adams' teachings inherently disclose the specific limitations of Applicant's claims.

As noted above, the Examiner has not provided any extrinsic evidence that Adams' system necessarily includes a client receiving an advertisement for a service that describes a portion of the service's capabilities. Moreover, M.P.E.P. 2112.IV states, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is

not sufficient to establish the inherency of that result or characteristic" (underlining in original). The Examiner's opinion that Adams' system inherently includes the use of advertisements "as a way of letting the user be away of the service available" or "to enable a subscriber to request privilege to use such service" are **not extrinsic evidence** that makes clear that the use of advertisements as recite in Applicants' claim 5 is necessarily present in Adams' system.

4. **Adams fails to disclose that the indication of the set of desired capabilities comprises an indication of the advertisement.**

As noted above, Adams fails to mention anything about advertisements, as admitted by the Examiner. Furthermore, Adams does not mention anything about a client indicating a set of desired capabilities as part of requesting a capability credential, *where the indication of the set of desired capabilities includes an indication of an advertisement for a service*. As noted above, the Examiner has merely speculated in hindsight that the use of advertisements would be beneficial to Adams' system without showing that Adams' system actually includes the use of advertisements. The Examiner has not provided any argument, explanation, or evidence showing that Adams' system includes a client indicating a set of desired capabilities, where that indication includes an indication of an advertisement for a service providing those capabilities.

The Examiner cites column 6, lines 31-67 of Adams and states, "the subscriber wants to access the relying party's service, but has to request [a] credential from the centralized privilege data selector by submitting the subscriber's identity and the relying party's identifier." The cited passage only mentions that a subscriber includes an identification of the relying party, but makes no mention of any indication of an advertisement that describes a portion of the first service's capabilities. Furthermore, the cited passage only teaches that Adams' subscriber unit includes the relying party's identifier when requesting a security certificate. The cited passage makes no mention of the client including an indication of an advertisement for a service as part of an indication of a set of desired capabilities, as required by Applicants' claim. Nor does the Examiner

mention anything about Adams' subscriber including an indication of an advertisement for the service when indicating a set of desired capabilities.

Thus, for at least the reasons above, the rejection of claim 21 is not supported by the cited art and removal thereof is respectfully requested.

Claims 22 and 38:

Adams fails to disclose that the indication of the advertisement is the advertisement itself.

The Examiner cites column 5, lines 14-18. However, as described above regarding claim 6, the cited portion of Adams makes no mention of any indication of an advertisement, nor that such an indication of an advertisement is the advertisement itself. Instead, the cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The cited passage provides no support for the Examiner's rejection. Furthermore, the Examiner admits that Adams makes no mention of advertisements.

In the Response to Arguments and the Advisory Action, the Examiner asserts that the use of advertisements is inherent in Adams' system. The Examiner is incorrect. Please refer to the remarks above regarding claim 21 for a detailed discussion regarding the fact that Adams' system does not inherently disclose the limitations of Applicants' claims. Furthermore, the Examiner have failed to provide nay extrinsic evidence, citation, explanation or interpretation illustrating that a subscriber unit's request *necessarily* indicates a set of desired capabilities that includes an indication of an advertisement where the indication of the advertisement is the advertisement itself. Following the Examiner's line of reasoning (that the use of advertisements are inherent in Adams' system) a subscriber's request would also have to inherently include an advertisement. There is nothing about Adams' system that inherently requires a

subscriber unit to include an advertisement (of which Adams makes no mention) in an indication of capabilities as part of requesting a capability credential. The Examiner's interpretation is clearly incorrect.

Claims 25 and 41:

Adams does not disclose an advertisement that is a protected advertisement that <u>describes the first service's capabilities but does not provide an interface to the first service's capabilities.</u>

The Examiner cites column 5, lines 14-18 where Adams teaches that a subscriber unit may send a request message to a website of a relying party to request access to another application controlled by the relying party to facilitate a financial transfer. As noted above, the cited passage makes no mention of any advertisements of any kind, let alone an advertisement that is a protected advertisement that describes the first service's capabilities but does not provide an interface to the first service's capabilities.

The Examiner argues, "the website describes the service, and the service can be provided upon authentication." However, the Examiner is clearly speculating regarding the workings of Adams' system. Adams does not mention that the website describes any service provided by the relying party. The Examiner's speculation regarding the website is improper and irrelevant in a rejection based on anticipation. Additionally, the Examiner is ignoring the specific limitations (in claim 21, from which claim 25 depends) regarding the client *receiving the advertisement* for the service and regarding where the client's indication of a set of desired capabilities *includes an indication of the advertisement*. The cited passage only mentions that a subscribing unit may send a request to a website. Adams does not mention anything about the subscribing unit including an indication of any website in an indication of a set of desired capabilities, as would be required according to the Examiner's rejection of claim 25.

In the Response to Arguments, the Examiner asserts (erroneously) that use of advertisements is inherent in Adams' system. The Examiner fails to provide any argument, evidence or interpretation of Adams that includes a protected advertisement describing a service's capabilities, but not providing an interface to the service's capabilities. As described above regarding claim 21, the Examiner's line of reasoning is that since Adams' system includes a subscriber unit sending a request to access a service, Adams inherently includes the specific limitations of Applicants' claims. However, there is nothing about Adams' system that necessarily requires a protected advertisement describing a service's capabilities, but not providing an interface to the service's capabilities. The Examiner's interpretation is clearly incorrect.

Claims 26, 27, 28, 42, 43 and 44:

Adams fails to disclose that the interface is configured to receive a protected advertisement for the first service, where the protected advertisement indicates an address for sending the capability credential request message to.

The Examiner cites column 5, lines 14 – 18 and column 6, lines 31 – 49. Neither of the cited passage makes any mention of a client receiving a protected advertisement that indicates an address to which to sending a capability credential request message. The first cited passage states that a subscriber unit may communicate a request over a global network link to a website of a relying party requesting access to another application controlled by the relying party to facilitate a financial transfer. The second cited passage describes a centralized privilege data selector that "selects among privilege data for a plurality of subscribers."

The Examiner considers the subscriber unit's request for access to an application controlled by the relying party the capability credential request message. However, nowhere does Adams describe a protected advertisement that indicates an address to which the subscriber unit sends its request.

Additionally, the Examiner has admitted that Adams makes "no specific mention of the advertisement". *See, e.g.*, Examiner's Answer, p. 5. The Examiner has provided no citation, argument or interpretation that Adams' system includes a protected advertisement, as described in claim 26. Since Adams is silent regarding a protected advertisement indicating an address for sending the capability credential request message to, Adams clearly fails to anticipate claim 26.

Claims 29 and 45:

Adams fails to disclose the interface configured to receive a protected advertisement for the first service, where said protected advertisement indicates an authentication service and request a capability credential by requesting a capability credential from the authentication service.

The Examiner cites column 5, lines 14 – 18 and column 6, lines 49 –67. However, as described previously, neither of these cited passages makes any mention of any advertisement further fail to describe a protected advertisement that indicates an authentication service.

The Examiner asserts, "the website describes the service, and the service can be provided upon authentication" (Examiner's Answer, p. 11). However, the Examiner's statement is not based on the actual teachings of Adams. Nowhere does Adams teach that "the website described the service". In fact, the only mention in Adams teaches regarding the website states, "the subscriber unit 200 may communicate a request over a global network link to a Website of the relying party requesting access to another application controlled by the relying party to facilitate a financial transfer." Adams does not mention anything about the website describing the service.

Moreover, whether or not Adams' website "describe[s] the service" and whether or not "the service can be provided upon authentication" is completely irrelevant to receiving a protected advertisement that indicates an authentication service. Presumably

the Examiner is equating Adams' subscriber unit requesting access to "another application controlled by the relying party" with requesting a capability credential from an authentication service. However, a subscriber unit requesting access to an application does not disclose anything about *receiving a protected advertisement* for a service that *indicates an authentication service*. The Examiner has not cited any portion of Adams that discloses this limitation of claim 29.

Thus, the rejection of claim 29 is not supported by the cited art and removal thereof is respectfully requested.

Claims 30 and 46:

Adams fails to disclose that the portion of the first service's capabilities that the capability credential indicates that the client has a right to use is the lesser of the level of the first service's capabilities that the client is authorized to use and the set of desired capabilities.

The Examiner again cites column 6, lines 49 – 67, where Adams describes the centralized privilege data selector that returns attribute certificates that match privilege criteria test data. However, the cited passage does not describe that the attribute certificates indicate a portion of a service's capabilities that a client has a right to use as being the lesser of the level of the service's capabilities that the client is authorized to use and the set of desired capabilities. In fact nowhere does Adams teach anything regarding this limitation. The Examiner is merely speculating regarding the workings of Adams' system, which is clearly improper.

Since Adams is silent regarding that *the portion of the first service's capabilities that the capability credential indicates that the client has a right to use <u>is the lesser of the level of the first service's capabilities that the client is authorized to use and the set of desired capabilities</u>*, Adams clearly fails to anticipate claim 30.

Second Ground of Rejection

Claims 3, 7, 19, 23, 35 and 39 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams.

Claim 7, 23 and 39:

1.   **Adams does not teach that the indication of the advertisement included in the client's capability credential request message as the indication of the set of desired capabilities is a Uniform Resource Identifier (URI) to said advertisement.**

In the Answer, the Examiner merely states that it would have been obvious "to use URI to indicate the advertisement because URI is standard identifier for accessing a website or advertisement" (Examiner's Answer, p. 9). The Examiner has not provided any evidence of record to support this contention. Moreover, even if the a URI is a standard for accessing a website, that would not suggest the specific use recited in claim 7, namely that *the indication of the advertisement included in the client's capability credential request message as the indication of the set of desired capabilities* is a Uniform Resource Identifier (URI) *to said advertisement*.

2.   **The Examiner has failed to provide a proper reason for modifying Adams.**

Appellants have argued that the Examiner has failed to provide a proper motivation for modifying the system of Adams' to use a URI. In the Answer, the Examiner merely states that it would have been obvious "to use URI to indicate the advertisement because URI is standard identifier for accessing a website or advertisement" (Examiner's Answer, p. 9). However, as admitted by the Examiner, Adams fails to mention anything about an advertisement. Furthermore, just because URI

may be a "standard identifier for accessing a website" does not mean that it is a standard for identifying an advertisement as claimed, and does not mean that one of ordinary skill in the art would have had a reason to modify Adams to use a URI as recited in claim 7. The Examiner also admits (regarding claim 5) that Adams does not mention use of an advertisement. Thus, the Examiner is now arguing that it would have been obvious to include a URI to an advertisement that is not taught by Adams. The Examiner has not provided any reasoning as to why one would modify Adams. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so in the prior art. M.P.E.P. § 2143.01. "[I]t remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." Memorandum on Supreme Court decision on *KSR Int'l. Co. v. Teleflex, Inc.*, Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007.

In the Response to Arguments, the Examiner argues that Adams discloses the "use of Web communication … to facilitate communication between entities", citing column 4, lines 14-18 of Adams. The Examiner then concludes, "the use of URI in Web is taught by the Adams reference as it is required for the system to be functional" (Examiner's Answer, p. 15). However, the cited passage does not describe anything regarding an indication of an advertisement is a URI to the advertisement, as recited in claim 7. Instead, the cited passage teaches a privilege test criteria data provider that may part of a relying party (or other) unit. Thus, the cited passage does not support the Examiner's argument.

Furthermore, claim 7 does not merely recite some general use of a URI. Instead, claim 7 requires that the indication of the advertisement, which (as recited in claim 5) is comprised in an indication of the set of desired capabilities, is a URI to the advertisement that describes a portion of the first service's capabilities. Since, as shown above regarding claim 5, from which claim 7 depends, Adams fails to teach anything regarding an indication of a set of desired capabilities, the Examiner must also provide motivation to include such an indication and to include a URI to a website in that indication of

desired capabilities, as required by claim 5 and claim 7. The Examiner has failed to do so.

Moreover, as noted in the M.P.E.P. at 2144.03, "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record". See, *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. That is precisely the case here. The Examiner has merely stated that it would be obvious to modify Adams to use a URI to an advertisement (that is not even taught by Adams) because "URI is standard identifier for accessing a website or advertisement".

Third Ground of Rejection

Claims 4, 20 and 36 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski et al. "An architecture for a Secure Service Discovery Service" (Hereinafter, Czerwinski). Appellants traverse this rejection for at least the reasons presented regarding the respective independent claims.

CONCLUSION

For the foregoing reasons submitted in the Appeal Brief, the previous Reply Brief and this Supplemental Reply Brief, it is submitted that the Examiner's rejections of claims 1-7, 9-23, 25-39 and 41-47 is erroneous, and reversal of his decision is respectfully requested.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-70400/RCK. This Reply Brief is submitted with a return receipt postcard.

Respectfully submitted,

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Date: ___April 3, 2008_____